

REMARKS

This is in response to the Office Action mailed March 18, 2003 for the above-captioned application and is filed concurrently with a Request for Continued Examination. Reconsideration of the application, as amended, in view of the remarks herein is respectfully requested.

The undersigned attorney has assumed responsibility for this case from the prior attorney of record, and a Power of Attorney is enclosed. Prior to addressing the Official Action, Applicants would like to point out that the statement made in the amendment mailed December 12, 2002 that "Fuhr further fails to disclose the phosphorous ester as disclosed and claimed by Applicant" is incorrect, since several of the compounds in Fuhr, including triphenyl phosphate, fall within the scope of the structure set forth in claim 1.

The claims have been amended to replace the phrase "characterized in that" with "wherein" or "comprising" as appropriate to put the claims in a more standard format for US prosecution. Added claims 18-21 are supported, *inter alia*, on Page 22, lines 4-14; Page 20, lines 27-28; and Page 23, line 10.

It is noted that no art rejections were specifically applied to claims 5-8 16 and 17. Clarification of the status of these claims is respectfully requested.

Claims 1, 2, 4, 9 and 10 stand rejected under 35 USC § 103 as obvious over Yamamoto et al (US 6,184,312) in view of Fuhr et al. (US 5,658,974). As characterized by the Examiner, the Yamamoto reference discloses a composition with all of the components of claim 1, except for the phosphoric ester (B). Fuhr is cited for a disclosure of flame proofed polycarbonate molding compositions that contain a phosphorous ester within the scope of the formula of claim 1. The Examiner argues that adding the phosphorous ester of Fuhr to the polycarbonate composition of Yamamoto would have been obvious. Applicants respectfully disagree.

In assessing obviousness as that term is used in patent law, one must take into account not only the concept that basic motivation to try a certain combination, but also the results obtained when a combination is actually made. For example, where the properties of a combination are particularly desirable or are unexpected, it is understood that the composition, as

a whole, is not obvious.

The compositions of the present invention exhibit properties which are both desirable, and unexpected. Looking at the Table on Page 32 of the application, it can be seen that compositions that contain both the phosphorous ester (BPADP in the examples), and a siloxane of the type claimed (Examples 1-5) are self-extinguishing within a short period of time, as reflected in the burn time results. In contrast, formulations with substantially higher levels of BPADP or organosiloxane alone (Comp Ex. 1 and 7), and compositions with a different type of silicone having exclusively alkyl rather than containing some aryl groups (Comp Ex. 5) have much longer burn times. As reflected in the enclosed declaration, this same type of response is observed when a different phosphorous ester, RDP, is used in place of BPADP.

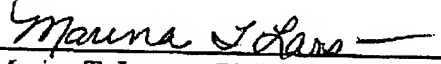
Nothing in the cited references suggests that there would be any connection between the use of the combination of the phosphorous ester and the specified type of organosiloxane and obtaining a reduced burn time. Indeed, one can derive from the results in the present application that the organosiloxane on its own increases burn time, since the burn time of Ex 1 is longer than that of Ex. 2 and the burn time of Comp Ex. 7 is very long. Contrary to this expectation, however, one can achieve the same burn out time and V0 fire rating as Comp Ex. 6 using the compositions of the invention (for example Ex. 2), without the dramatic decrease in impact strength caused by high levels of phosphorous flame retardant. See also example in Rule 132 Declaration.

In view of these characteristics of the compositions of the invention, Applicants submit that rejection of claims 1, 2, 4, 9 and 10 under 35 USC § 103 should be withdrawn.

Claims 3 and 12-15 are also rejected under 35 USC § 103 as obvious over the combination of Yamamoto and Fuhr in view of one or more additional references. Applicants submit that these claims are allowable for the same reasons as discussed above.

For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,


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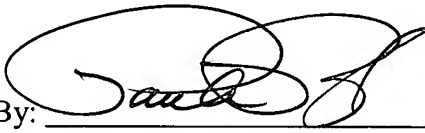
III. CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number UCAL250CON4.

Respectfully submitted,
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Date: Aug. 22, 2003

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